

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES H. ANGLEA

Appeal No. 1998-2019
Application No. 08/398,752

ON BRIEF

Before COHEN, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 20, which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to a device used for plugging an opening into and locating a receptacle in an anchor for a base used on a playing field. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.¹

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Shopbell	3,371,647	Mar. 5, 1968
Graw	2,457,655	Jun. 10, 1976 ²
(German patent document)		

The following rejections are before us for review.

1. Claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

¹ The copy of claim 1 in the appendix to the appellant's brief contains a minor error in line 11 thereof in that the claim of record reads "playing field surface" and not "playing ground surface."

² An English language translation of this reference, prepared by the Patent and Trademark Office, is appended hereto.

2. Claims 1-5 and 11-15 stand rejected under 35 U.S.C. § 103³ as being unpatentable over Shopbell in view of Graw.

Reference is made to the brief (Paper No. 13) and the final rejection and answer (Paper Nos. 11 and 14) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

The examiner's first basis for rejecting the claims as indefinite is that, in claims 1 and 11,

the expression "elastomeric material" is seen to be redundant as well as a double inclusion, since a prior description (elastic body) of the body clearly [denotes] the body as being elastomeric. It is not clear as to what is intended to be added by the expression "elastomeric material" [answer, page 4].

³ The examiner's reference to section 102 as the basis for this rejection on page 3 of the answer is presumed to have been an error. The rejection stated in the final rejection (Paper No. 11, page 2) was under 35 U.S.C. § 103.

We note that an elastomeric material is "a rubber-like synthetic polymer, as silicone rubber" (Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988)). Therefore, we are in complete agreement with the appellant (brief, page 7) that

the phrase "elastomeric material" in claims 1 and 11 is not redundant of the phrase "an elastic body". Although a body made from an elastomeric material may be an elastic body, an elastic body is not always made from elastomeric material. For example, a spring is an elastic body that may be made from steel or other ferrous material, which is not considered to be elastomeric material. Thus, the claim language modifies the elastic body so that it is made from elastomeric material and is not a redundant statement of the elastic body.

With particular regard to claims 3, 8, 10, 12, 18 and 20, the examiner (answer, page 5) further asserts that "[i]t is not clear how the flexible indicator [is] 'bristle-like'? It is suggested the expression be changed to -a plurality of closely spaced elongated flexible elements."

In response to this rejection, the appellant (brief, page 8) points out that "the word 'bristle' is defined as 'a stiff, glossy hair of swine especially one of those growing on the back, used for making brushes; also, a similar hair on other animals.' (Webster's New Universal Unabridged Dictionary, Deluxe Second Edition, copyrighted in 1972)." As further noted by the appellant, the "bristle-like members 34" are disclosed in the appellant's specification (page 6) as being made from brightly colored plastic.

Having reviewed the appellant's disclosure as a whole, we are satisfied that one of ordinary skill in the art would have understood the "bristle-like members" to be elongated

strands of material which differ from "bristles" in that they need not be made of hair.

Accordingly, we conclude that the phrase "bristle-like" does not render the claims indefinite.

For the foregoing reasons, we shall not sustain the examiner's rejection of claims 1-20 under 35 U.S.C. § 112, second paragraph.

The obviousness rejection

Shopbell, the primary reference relied upon by the examiner in rejecting the claims, discloses an athletic field marker comprising a soft, pliable rubber-like post (1) and a soft rubber base (4) bonded to the lower end of the post (1) and provided with a centrally located depending projection or plug (5) which may be of tubular construction. An annular rib (6) is formed on the projection or plug (5). The projection or plug (5) is adapted be received in a tubular metal socket or receptacle (8) which is driven into the ground, with the rib (6) received in an annular groove (7) formed in the interior of the socket or receptacle. The objective of the Shopbell marker is to overcome recognized problems with conventional corner flags.

Specifically, the Shopbell marker avoids the problem of a flag being blown into the field of play on a windy day, suddenly contacting a player who will thus be unexpectedly called out-of-bounds under the rules of the game (column 1, lines 39-72). With the Shopbell marker, there is no possible chance of a player touching the post unless he actually goes out-of-bounds.

Additionally, the soft, pliable post is "absolutely harmless to players coming into contact

therewith" (column 2, lines 6-10), in contrast to the metal flag staff of the conventional corner flag.

Graw discloses a road marker for a road surface, the marker comprising a plurality of plastic bristles (2) which are bonded together at one end thereof and fastened by cement (3) into the road surface (Figure 1), arranged at an oblong ridge of a brush (4) which is fastened in a slot in the road surface by cement (3) (Figure 2), attached to a conventional street nail (5) (Figure 3) or attached to a thin layer or disk (6) which is glued to the road surface. The bristles may be elastically bent in all directions on the road surface without causing significant noise (translation, page 2). Graw notes that the road markers are "especially inexpensive to manufacture if a bundle of bristles or hair which is combined in a common mount, is involved" (translation, page 2).

In rejecting claims 1-5 and 11-15 under 35 U.S.C. § 103, the examiner has implicitly determined that Shopbell fails to disclose all of the limitations of the device recited in independent claims 1 and 11⁴ and takes the position that it would have been obvious to substitute bristle members for the solid body 1 of Shopbell in view of the teachings of Graw, "since such would be seen to reduce construction cost as well as simplify the construction of the

⁴ As the examiner has not pointed out these differences on the record, to specifically address the examiner's findings in this regard would require speculation on our part.

flexible body" (final rejection, page 2). On page 4 of the answer, the examiner states that it would have been obvious to substitute bristle members for the solid body of Shopbell in

view of the teachings of Graw, "since such would be seen to reduce the possibility of injury to a player impacting the marker."

While it is true that both Shopbell and Graw are directed to flexible markers which will be easily seen and capable of flexing when hit, we also note that Shopbell is concerned with providing a marker which will not be blown into the field of play and which is absolutely harmless to players coming in contact therewith. Therefore, the appellant's arguments on page 11 of the brief are particularly well taken. Specifically, as pointed out by the appellant, replacement of the solid body of Shopbell with bristles, which can be deflected by wind and which could pass through face masks and clothing of players causing players to be injured, appears to be contrary to the stated objectives of Shopbell. Thus, even if substitution of bristles for the pliable, rubber-like post of Shopbell were to render the Shopbell marker simpler and less expensive to construct, as suggested by the examiner,⁵ one of ordinary skill in the art having read the disclosure and objectives of Shopbell would not have considered such a

⁵ The examiner has not adduced any evidence that this is, in fact, the case.

construction particularly desirable for use as an athletic field marker and would not have been led to make the modification.⁶

For the foregoing reasons, we shall not sustain the examiner's rejection of claims 1-5 and 11-15 under 35 U.S.C. § 103 as being unpatentable over Shopbell in view of Graw.

REMAND TO THE EXAMINER

While we do not agree with the examiner that it would have been obvious, in view of the combined teachings of Shopbell and Graw, to substitute bristle members for the post 1 of Shopbell, as discussed above, we note that appellant's claim 1, for example, does not require bristle members. Therefore, pursuant to 37 CFR § 1.196(d), we remand the application to the examiner to consider whether Shopbell anticipates any of appellant's claims. In particular, with regard to claim 1, the examiner should consider whether the post 1 of Shopbell's marker is "sufficiently flexible to be deflected during ground care operations . . . and be visible after such ground care operations" and whether the soft rubber base 4 and plug 5 form an elastic body which has a shape "sufficiently large to extend across the opening" of a receptacle and are made of an elastomeric material "capable of being deformed to insert a portion of said body through the opening and expanded to form a plug across the opening" as called for in claim 1.

⁶ Where the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, the proposed modification would not have been obvious. See Tec Air Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1360, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-20 under 35 U.S.C. § 112, second paragraph, and claims 1-5 and 11-15 under 35 U.S.C. § 103 is reversed.

The application is remanded to the examiner for consideration of the above-mentioned issues.

REVERSED and REMANDED

IRWIN CHARLES COHEN
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR

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